

Notice of Allowability

Application No.

10/632,254

Applicant(s)

GHOSH ET AL.

Examiner

Elizabeth D. Wood

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the amendment filed 6/2/05.
2. ☒ The allowed claim(s) is/are 1-9 and 11-24.
3. ☒ The drawings filed on 01 August 2003 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date 7/14/05.
7. ☒ Examiner's Amendment/Comment re: Claim 6
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

The following is an examiner's statement of reasons for allowance: The prior art of record, either alone or in combination fails to anticipate or render obvious the instantly claimed process for preparing xylene. The amended claims now clearly recite a process for toluene methylation that clearly defines two stages, the start up and the run stages, each with definably distinct characteristics. The closest prior art of record comprises the Brown et al. document, which does not teach or suggest two different stages of operation. Furthermore, applicant's specification provides additional evidence regarding the benefits obtained by an additional start-up mode in this particular reaction. The specification demonstrates that very long run times can be obtained while maintaining high product selectivity. This is clearly an added benefit not taught by the prior art, nor would such flow naturally from carrying out the process of Brown et al. Accordingly, the preponderance of the evidence on this record supports the patentability of the herein claimed process.

The examiner notes that claim 22 lacks literal support in the originally filed specification. The examiner is not unmindful of the decision in *Ex parte Grasselli*, 213 USPQ 393; however the fact pattern in this case is much closer to that of *Ex parte Parks* (30 USPQ2d 1234). In *Grasselli*, it was apparent that the negative limitation introduced a new concept. In the instant situation (as in *Parks*) it is clear that had applicant intended to steam his catalyst, then surely some mention of this step would have appeared in the specification.

The examiner also notes that applicant's response filed June 2, 2005 makes reference to the cancellation of claim 2. However, claim 2 has not been cancelled and

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the reference to such is merely an oversight. To clarify the record, see the attached interview summary form that accompanies this office action.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth D. Wood whose telephone number is 571-272-1377. The examiner can normally be reached on M-F, 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Elizabeth D. Wood
Primary Examiner
Art Unit 1755

edw